

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
David P. Vellante, et al.)
Serial No. 09/845,539)
Filed: April 30, 2001)
For: Method and System for Assessing)
and Quantifying the Business Value of)
an Information Technology (IT) Application)
or Set of Applications)

RECEIVED
FEB 04 2002
Technology Center 2100

COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Sir:

Pursuit to the provisions of 37 C.F.R. §§1.97 and 1.98, submitted herewith is an Information Disclosure Statement. The statement includes only documents which are listed on form PTO/SB/08A.

REMARKS

Document No. 1 is a teaching aid prepared by the assignee, ITcentrix, Inc. The document was developed in September, 1999 and pages 11 and 26 thereof are relevant. It is submitted that the document is not a "printed publication" under the provisions of the Patent Statute in that it was utilized in conjunction with two, one-day restricted and confidential training sessions within the Compaq corporation, each limited to twenty selected senior employees. These employees were required to be certified for proper use of the divulged information only within the Company organization. Page 26 describes only the subject matter of blocks 16, 18, 20 and 22 of the figures of the application. An elaboration of the restricted and very limited dissemination of the document is set forth in the attached Declaration of the president of the assignee.

The courts have consistently held that a limited, restricted form of dissemination as herein described does not constitute a "printed publication" under the provisions of §102 of the Patent Statute. For example, in *Southwest Aerospace Corp v. Teledyne Industries, Inc.*, 702F. Supp. 870, 881, 9 U.S.P.Q. 2d 1949, 1957 (N.D. ALA., 1988) documents passed between a customer and supplier under confidentiality agreement did not constitute a publication. In *Manville Sales Corp. v. Paramount Systems, Inc.*, 3

U.S.P.Q. 2d 1042, 1046 (E.D. PA. 1987) the Court commented that the Plaintiffs' confidentiality legend challenged the Defendants assertion of publication. More recently, in *Northern Telecom, Inc. v. Data Point Corp.*, 908F pp 931, 936, 15 U.S.P.Q. dd 1321, 1325 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990) four reports on a complex military system that were distributed to approximately 50 persons or organizations involved in a project were not considered to be so accessible to the public as to constitute printed publications.

Document No. 2 is concerned with underlying models which are related to the cost piece but not the value piece. This is a website.

Document 3 is concerned with underlying models with related to the cost piece as opposed to the value piece.

Document. 4 is a print-out of various addresses of the website of Enamics, a company.

Document 5 is the website of CIOview Corp. describing financial methodology to quantify the return on investment of IT projects.

Document 6 is a website of Ajunto, Inc. The organization provides a decision support engine that maps buyer criteria with seller and product attributes.

Document 7 is a website of an organization identified as Meta Group, Inc. The organization seeks to carry out IT value measurement.

Document 8 is an article focusing on solutions to creating quantifiable metrics that measure IT value. Probability distribution is introduced as a measurement tool.

Document 9 discusses five steps to "value capture". The document touches on issues of users in queuing theory-like algorithms and provides graphs of a sample scorecard.

Document 10 is a web version of CIO magazine. The document talks about the difficulties of measuring IT value and some of the traditional methods for quantification.

Document 11 is a summary of various value approaches which companies are employing.

Document 12 provides a case study on using value metrics to decide between three new project alternatives. The document looks at Hubbard Ross methodology.

Document 13 employs a statistical technique to confirm executive perceptions of IT business value as a valid means of assessing IT business value.

Document 14 looks to the results of a survey by industry on four IT productivity metrics.

Document 15 looks at the results of a survey by industry on four IT productivity metrics.

Document 16 looks at the results of a survey by industry on four IT productivity metrics.

Document 17 provides an analysis of regression equations to quantify the contribution of IT capital.

Document 18 presents views by the Meta Group on the business discipline of IT.

In document 19, an IS panel discusses the changing relationship of IT systems and the businesses they support.

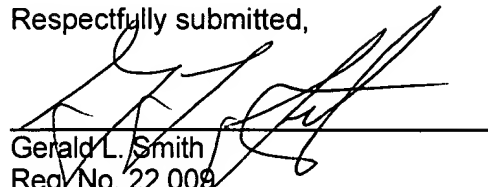
Document 20 provides a description of the Meta Group information ecosystem model.

Document 21 provides a view on balancing the risk/return model for IT value.

Document 22 is a Giga Information Group reprint espousing the measuring of business value to sell IT internally.

Document 23 is a biography of Paul A. Strassmann.

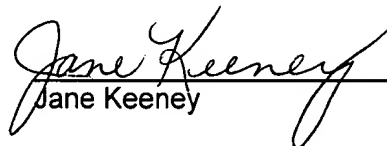
Respectfully submitted,



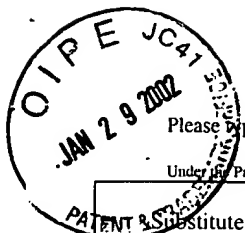
Gerald L. Smith
Reg. No. 22,009
MUELLER AND SMITH, L.P.A.
MUELLER-SMITH BUILDING
7700 Rivers Edge Drive
Columbus, Ohio 43235
(614) 436-0600

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on January 15, 2002



Jane Keeney



Please type a plus sign (+) inside this box → ☐

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it contains a valid OMB control number.

PTO/SB/OBA (10-96)

Approved for use through 10/31/99 OMB 0651-0031

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Complete if Known

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet 1 of 3

Application Number	09/845,539
Filing Date	April 30, 2001
First Named Inventor	David P. Vellante
Group Art Unit	
Examiner Name	
Attorney Docket Number	ITC 2-001

OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS

EXAMINER INITIALS*	CITE NO. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the Item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), Publisher, city and/or country where published	T ²
	1	Introduction to Selling the Value of Compaq SAN Solutions Workbook by Itcentrix, Inc., Framingham, MA, Sept, 1999	
	2.	TI ² Total Impact of Innovation, Gartner Group, Stamford, CT, 2000, https://iisprod.ggti2.com/ti2/asp/public/Default.asp (p 1); https://iisprod.ggti2.com/ti2/asp/Public/availmodels.asp?unique=6302581 (pp 1-3); https://iisprod.ggti2.com/image/ti2/HV_Tab_1.gif (p 1); https://iisprod.ggti2.com/image/ti2/HV_Tab_3.gif (p 1); https://iisprod.ggti2.com/image/ti2/ASP_Tab_1.gif (p 1); https://iisprod.ggti2.com/image/ti2/ASP_Tab_3.gif (p 1); http://gartner12.gartnerweb.com/bp/static/itmanhome.html (p 1); http://gartner12.gartnerweb.com/public/static/events/tco/tco.html (pp 1-2)	
	3.	TCO – Microsoft Exchange; A Total Economic Impact Study, Giga Information Group, Sept. 1998, Microsoft Tech Net. http://www.microsoft.com/technet/tco/gigrpl.asp (pp 1-33)	
	4.	enamics website, http://www.enamics.com/home.html (p 1); http://www.enamics.com/products_home.htm (p 1); http://www.enamics.com/products_core.htm (p 1); http://www.enamics.com/products_bus.htm (p 1); http://www.enamics.com/products_proc.htm (p 1); http://www.enamics.com/products_app.htm (p 1); http://www.enamics.com/products_arch.htm (p 1); http://www.enamics.com/products_know.htm (p 1)	
	5.	CIO Corp. website, http://www.cioview.com/ (p 1); http://www.cioview.com/about/about.htm (p 1); http://www.cioview.com/products/products_main.htm (pp 1-2); http://www.cioview.com/tour/CIOViewMenu.htm (p 1); http://www.cioview.com/CIOViewWorkGeneric/main.html?screen=3&did=972663453703 (p 1); http://www.cioview.com/CIOViewWorkGeneric/main.html?screen=4&did=972663472824 (p 1); http://www.cioview.com/business/rpt_main.htm (pp 1-19)	
	6.	Ajuntio, Inc. website, http://www.ajuntio.com/ (p 1); http://www.ajuntio.com/AppOrder/app_index.html (pp 1-2)	
	7.	Meta Group website, http://www.metagroup.com/communities/value/ed037.htm (pp 1-3); http://www.metagroup.com/communities/value/ed015.htm (pp 1-6); http://www.metagroup.com/communities/value/ed043.htm (pp 1-3); http://domino.metagroup.com/newweb.nsf/oPressRelease/36D91A5A930B44788525696D005 (pp 1-3)	
	8.	Everything Is Measurable, CIO Enterprise Magazine, Nov. 15, 1997, http://www.cio.com/archive/enterprise/111597_checks_content.html (pp 1-6)	
	9.	Maximizing IT Investments, CIO Enterprise Magazine, July 15, 1999, http://www.cio.com/archive/enterprise/071599_checks_content.html (pp 1-8)	
	10.	Measuring IT Value Learning Center – The Basics Darwin Online, June 1, 2000, http://www.darwinmag.com/learn/metrics/basics.html (p 1)	
Examiner Signature		Date Considered	

RECEIVED
FEB 04 2002
Technology Center 21-3

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Unique citation designation number ² Applicant is to place a check mark here if English translation is attached.



Please type a plus sign (+) inside this box → ☐

PTO/SB/OBA (10-96)

Approved for use through 10/31/99 OMB 0651-0031

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it contains a valid OMB control number.

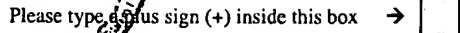
Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)				Complete if Known	
				Application Number	09/845,539
				Filing Date	April 30, 2001
				First Named Inventor	David P. Vellante
				Group Art Unit	
Examiner Name				Attorney Docket Number	ITC 2-001
Sheet	2	of	3		

OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS			
EXAMINER INITIALS*	CITE NO. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the Item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), Publisher, city and/or country where published	T ²
	11.	Value Made Visible, CIO Magazine, May 1, 2000, http://www.2.cio.com/archive/050100_method_content.html (pp 1-11)	
	12.	Capital Blue Cross, CIO Magazine, Feb. 15, 2000, http://www.2.cio.com/archive/021500_value_content.html (pp 1-8)	
	13.	Perceptions of IT Business Value, CRITO, 1998, 1999, (pp 1-31)	
	14.	Executives' Perceptions of IT Payoffs Using Strategic Intent For IT, CRITO, Nov., 1999 (pp 1-15)	
	15.	When Context Matters: Making Sense of Executives' Perceptions of IT Payoffs using Strategic Intent for IT, CRITO, Nov. 1999, (pp 1-17)	
	16.	A Process-oriented Assessment of the Alignment of Information Systems and Business Strategy: Implications for IT Business Value, CRITO, July 1999, (pp 1-10)	
	17.	Disaggregating the Return on Investment To IT Capital, CRITO, Sept. 1988, (pp 1-6)	
	18.	The IT Leadership Vacuum, CIO Magazine Sept 15, 1999, http://www.cio.com/archive/091599_view_content.html (pp 1-7)	
	19.	Value Judgements, CIO Magazine, Feb. 1997. http://www.cio.com/archive/020197_round_content.html (pp 1-7)	
	20.	Adapt or Die, CIO Magazine, Feb. 1, 1997, http://www.cio.com/archive/020197_meta_print.html (pp 1-5)	
	21.	Risk Vs. Return, Information Week Issue: 637, June 30, 1997, http://www.techweb.com/se/directlink.cgi?IWK19970630S0053 (pp 1-2)	

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Unique citation designation number ² Applicant is to place a check mark here if English translation is attached.



Approved for use through 10/31/99 OMB 0651-0031
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Information unless it contains a valid OMB control number.

¹Unique citation designation number ² Applicant is to place a check mark here if English translation is attached.